

Remarks

By the current amendment claims 1, 15, 19 and 24 have been amended, with claims 4-6 and 18 being canceled. Claims 9, 10, 12, and 13 have been amended to make adjustments to dependency based on the substantive amendments. Claims 1-3, 7-17 and 19-23 remain pending in the application.

Objection under 37 C.F.R. § 1.84(p)(5)

The drawings were objected to as failing to comply with the regulations because they included one or more reference signs not mentioned in the specification. FIG. 1 has been amended to delete the reference number 114, with an amended replacement sheet attached to this response. Applicant respectfully requests that this objection be withdrawn and the drawings accepted.

Rejection under 35 U.S.C. § 102

Claims 1-2, 4-6, 10-18 and 20-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Westwood (US 4,647,997). The Examiner provided a lengthy summary of the reference in the office action. For purposes of space, Applicant will not repeat the summary here.

Based on the amendments of independent claims 1 and 15, Applicant submits that Westwood does not anticipate the present application as it does not recite the features as currently claimed. Claim 1 has been amended to incorporate the limitations of now-canceled claims 5-7. Westwood does not recite the features of a frame that comprises a shroud or supports an airstream stripper. Thus, independent claims 1 and 15, along with their dependent claims 2 and 10-18 are allowable.

Claims 1-6, 13-18 and 20-23 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hashizume et al (US 6,449,119). As is the case above, Hashizume does not anticipate the present application as it does not recite the features as currently claimed by independent claims 1 and 15. Hashizume does not recite the feature of a frame that comprises a shroud as disclosed in the present

invention. Based on the amendments to independent claims 1 and 15, it is asserted that claims 1 and 15, along with their dependent claims 2-4, 13, 14, and 16-18 are allowable.

Claims 20-23 were rejected under both Westwood and Hashizume. Claim 20 requires "means for limiting the aerodynamic excitation resulting from air currents generated by the spinning disc." This claim thus invokes 35 U.S.C. § 112, sixth paragraph. Whatever the result may have been under prior PTO practice, the PTO must construe functional limitations in accordance with the corresponding structure disclosed in the specification when examining patents. In re Donaldson, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994) (en banc). Donaldson is further embodied in the Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, P6, 65 FR 38510, Federal Register Vol. 65, No. 120, June 21, 2000. Applicant's corresponding structure at the least includes an airstream stripper supportable downstream of the actuator with respect to the direction of the air currents produced by the rotating disc and a frame supportable by the enclosure. The frame further comprises a shroud defining a perimeter surface substantially transverse to the data storage disc outer edge and intersecting the airstream stripper, wherein the shroud comprises a fin defining a planar surface extending from a perimeter surface and substantially coextensive with the data storage disc.

As discussed above, neither Westwood or Hashizume disclose an airstream stripper supported by a frame, with the frame further comprising a shroud. As such, the pending claims are not anticipated by the prior art, and withdrawal of the rejections under § 102 is respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 7-9, 19 and 24 are rejected as being unpatentable over Hashizume in view of Izumi et al. (US 6,487,038).

In order to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one skilled in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

In the instance of the present application, Hashizume, in view of Izumi does not teach or suggest all of the claim limitations. In claim 1, upon which claims 8 and 9 now depend, a shroud defines a perimeter surface 158 substantially transverse to the data storage disc outer edge and intersecting the airstream stripper. The shroud of Izumi, which extends completely around the disc, could not intersect the stripper of Hashizume in the manner contemplated by the present invention. As shown in FIG. 1 of the present invention, the perimeter surface 158, which forms the shroud, intersects the airstream stripper 140. In addition, the shroud of the present invention is upstream of the airstream stripper when deployed in its operational configuration. It would be impossible to configure the shroud of Izumi with the airstream stripper of Hashizume in order to have the shroud be upstream of the airstream stripper. In addition to claim 1, claims 19 and 24 have been amended to further clarify the location of the shroud in relation to the airstream stripper. Based on the above, Applicant submits that the references as combined do not teach or suggest all of the claim limitations, and that the present application is not obvious. Applicant respectfully requests that the rejection be withdrawn and the claims be allowed.

Conclusion

This is a complete response to the Office Action mailed August 14, 2003. The Amendments contained herein are proper, do not add new matter, and do not place an undue burden or require additional searching by the Examiner. All rejections are obviated such that the pending claims 1-3, 7-17 and 19-23 are in condition to pass to allowance. The Examiner is encouraged to contact the

Applicant's representative below for any matter that might further facilitate prosecution on the merits.

Respectfully submitted,
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(Assignee of the Entire Interest)

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Date

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